

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

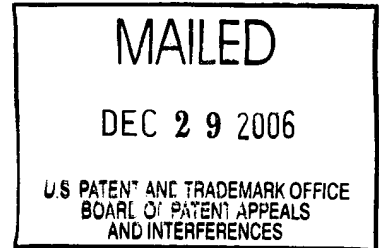
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex Parte CARY LEE BATES and PAUL REUBEN DAY

Appeal No. 2006-2753
Application No. 09/292,444

ON BRIEF



Before KRASS, BARRETT and GROSS, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-10, 12-14, 16, and 17.

The invention is directed to identifying hypertext links in document printouts. A document to be printed is scanned for identifying local hypertext links within the document. A page location of each identified local hypertext link within the document is computed and stored. Printable objects are sequentially checked to identify each printable object within a hypertext anchor tag. Each identified printable object within a hypertext anchor tag is rendered with a predefined indication of the hypertext link.

Representative independent claim 1 is reproduced as follows:

1. A computer implemented method for identifying hypertext links in document printouts comprising the steps of:

scanning a document to be printed and identifying local hypertext links within the document,

computing and storing a page location of each identified local hypertext link within the document,

sequentially checking printable objects to identify each printable object within a hypertext anchor tag; and

rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link including printing a corresponding uniform resource locator (URL) for each external hypertext link.

The Examiner relies on the following references:

Stork et al. (Stork)	5,781,914	July 14, 1998
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Advanced Microsoft Word, "Footnotes and Endnotes", Available at:
<http://www.utexas.edu/cc/training/handouts/wordadv/.01/224/01>, Copyright 1996, Computation Center, The University of Texas at Austin, (Advanced Microsoft).
Microsoft Word Tutorial, "Microsoft Word Basic Features", Available at:
<http://baycongroup.com/wlesson0.htm>, Microsoft Word 1997, (MicroSoft).

Claims 1-3, 6, 10, 12-14, 16, and 17 stand rejected under 35 U.S.C. §102(e) as anticipated by Stork.

Claims 4, 5, and 7-9 stand rejected under 35 U.S.C. §103. As evidence of obviousness, the Examiner cites Stork, adding, alternatively, Microsoft with regard to claims 4, 5, and 8, and Advanced Microsoft with regard to claims 7 and 9.

Reference is made to the Briefs and Answer for the respective positions of Appellants and the Examiner.

OPINION

At the outset, we note that this appeal is related to prior Appeal No. 2004-0224, wherein the same panel of this Board, on November 18, 2004, reversed the Examiner's decision on the same claims as are now before us.

The only difference between the earlier appeal and the present one is that claims 1-3, 6, 10, 12-14, 16, and 17 now stand rejected under 35 U.S.C. §102(e) in view of Stork, rather than under 35 U.S.C. §103 in view of Stork, as in the earlier appeal.

In our previous decision, we determined that the Examiner did not present a prima facie case of obviousness in combining a U.S. Patent to Kogan with Stork, in order to provide for Stork's allegedly missing teaching of the claimed "checking printable objects to identify each printable object within a hypertext anchor tag."

Now, the Examiner finds that Stork, alone, discloses the instant claimed subject matter, with the "checking printable objects..." limitation being taught at column 8, lines 30-37. The indicated portion of Stork recites, in toto, the following:

The present invention includes a process by which a hypertext document is converted into a plain paper document. One embodiment of this process is shown in FIG. 5. The hardcopy document that results contains hypertext link information in machine readable format to enable conversion back into a hypertext document format. Thus, the link information will be available to the user to enable a reversal back into a hypertext document.

Thus, the portion of Stork relied on by the Examiner for a teaching of “sequentially checking printable objects to identify each printable object within a hypertext anchor tag” is concerned with converting hypertext documents into plain paper documents and back again into hypertext documents via hypertext link information in machine readable format.

While the Examiner’s explanation of the rejections is not a beacon of clarity, we will, nevertheless, sustain the rejection of the independent claims under 35 U.S.C. §102(e) for the following reasons.

Stork describes hypertext link information in hardcopy documents, and that information is in machine readable form to permit conversion back to a hypertext document. Appellants argue, at page 4 of the Reply Brief, that the “machine readable encoded information provided by Stork...in a document printout is not equivalent to, nor does not achieve, nor suggest the step of printing a corresponding uniform resource locator (URL) for each external hypertext link.” We disagree.

As broadly claimed, the instant invention does not require the URL to be in “human-readable” form, only that there be a printing of a corresponding URL for each external hyperlink. The bar code on the left side of the hard copy document in Figure 1 of Stork is clearly such a printing of an URL since this bar code permits a conversion back into a hyperdocument through the URL information contained therein. While the bar code is not human-readable, it is machine-readable and independent claims 1, 10, 13, and 17 do not preclude this.

The hyperwords in Stork are detected in a bit map, and in one embodiment, a template is used (column 8, lines 43-48. Clearly, these hyperwords of Stork are “printable objects” and are identified, as claimed.

As far as rendering each identified printable object within the hypertext anchor tag with a predefined indication of the hypertext link including printing a corresponding uniform resource locator (URL) for each external hypertext ink, as claimed, again, Figure 1 of Stork shows such a printed URL. Table 2 at page 4 of the instant specification shows what is intended by rendering each identified printable object with a predefined indication of the hypertext link including printing a corresponding URL, (Note the URL for the picture frame catalog identified in the hypertext link), but we find nothing in the language of the independent claims which requires just what is shown in Table 2. For the reasons supra, the broad language of the claims regarding rendering the identified printable object, including a printing of a corresponding URL, is clearly shown in Figure 1 of Stork.

Thus, we will sustain the rejection of claims 1, 2, 6, 10, 13, and 17 under 35 U.S.C. §102(e), since claims 2, 6, 10, 13, and 17 are either not separately argued or Appellants rely on arguments similar to those relative to claim 1.

We will not sustain the rejection of claims 3, 12, 14, and 16 under 35 U.S.C. §102(e) because these claims specify printing a specified page number for the local hypertext link with the printable object and/or computing and storing a page location of each identified local hypertext link within the document. We find no such teachings in Stork.

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We also will not sustain the rejection of claims 4, 5, and 7-9 under 35 U.S.C. §103 because claims 4 and 5 depend from claim 3 and claims 7-9 recite various methods of printing the URL, either in a footnote, or superscript, or bold form. While the Examiner has shown such printing forms in secondary references, there would have been no sufficient reason for printing the URLs of Stork in such forms, and the Examiner has not adequately explained otherwise.

We have sustained the rejection of claims 1, 2, 6, 10, 13, and 17 35 U.S.C. §102(e), but we have not sustained the rejection of claims 3, 12, 14, and 16 35 U.S.C. §102(e). We have also not sustained the rejection of claims 4, 5, and 7-9 35 U.S.C. §103.

Accordingly, the Examiner's decision is affirmed-in-part.

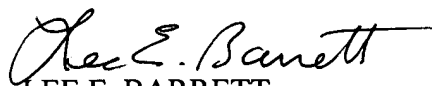
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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv).

AFFIRMED-IN-PART



ERROL A. KRASS
Administrative Patent Judge



LEE E. BARRETT
Administrative Patent Judge



ANITA PELLMAN GROSS
Administrative Patent Judge

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